

**REMARKS****Summary of the Office Action**

Claims 10-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 2001/0021145 to Ichimura (hereinafter "Ichimura").

Claims 4-9 and 17-19 are allowed.

**Summary of the Response to the Office Action**

Applicants have amended claim 10 to differently describe embodiments of the disclosure of the instant application's specification. Accordingly, claims 1-19 remain currently pending, with claims 1-3 currently withdrawn from consideration.

**Rejection under 35 U.S.C. § 102(a) and Summary of Discussion with Examiner**

Claims 10-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ichimura. Applicants have amended claim 10 to differently describe embodiments of the disclosure of the instant application's specification. To the extent that these rejections might be deemed to still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Examiner Joshua Pritchett is thanked for the courtesies extended to Applicants' undersigned representative during a telephone discussion on May 30, 2006. During that telephone discussion, Applicants' undersigned representative reiterated the arguments explained in the previous Amendment filed on February 27, 2006 regarding the instant application's claim 10's feature of light being reflected from a solid immersion lens and being acquired through the

optical system. Applicants' undersigned representative explained how the Final Office Action did not address this particular argument at pages 4-5 in the "Response to Arguments" section.

The Examiner noted to Applicants' undersigned representative in response that he does not believe that the current language of claim 10 specifically describes that light is reflected from the solid immersion lens. In other words, the Examiner explained that he believes that claim 10's previously-described feature of "acquiring an image containing reflected light from a solid immersion lens through an optical system" is met by a disclosure teaching light being reflected from some other structure, such as the optical disk 51 shown in Fig. 6 of the applied Ichimura reference, and then passing this reflected light through a solid immersion lens and then through an optical system, as allegedly shown in Fig. 6 of Ichimura.

Accordingly, the Examiner indicated that if Applicants would like to continue asserting this particular argument regarding this subject feature of claim 10, then the claim should be amended to specifically describe that the light is reflected by the solid immersion lens.

As a result, Applicants have opted to further amend independent claim 10 to more particularly describe this feature by explaining that independent claim 10's sample observation method of observing a sample includes "a configuring step of configuring a solid immersion lens so that it reflects light in a direction towards an optical system" and "a position adjustment step of acquiring an image containing light that has been reflected by the solid immersion lens through the optical system to which light from a sample is incident, and adjusting a position of the solid immersion lens relative to the optical system, with reference to the image."

Applicants respectfully submit, on the other hand, that in the apparatus disclosed in Ichimura, the reflected light from the optical storage medium, which is an observation sample, is

used for controlling the actuator. See, for example, paragraphs [0027], [0028], and Claim 1 of Ichimura.

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because Ichimura does not teach, or even suggest, each feature of independent claim 10. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, Applicants respectfully assert that dependent claims 11-16 are allowable at least because of their dependence from independent claim 10, and the reasons set forth above.

The Examiner is thanked for the indication that all of the remaining claims 4-9 and 17-19 currently under consideration are allowed.

### **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request the entry of the Amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this

application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

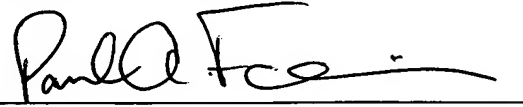
This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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Dated: June 21, 2006

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